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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/867,687	05/31/2001	Patricia Kesling	XMS-102	8151
36183 7590 07/09/2007 PAUL, HASTINGS, JANOFSKY & WALKER LLP P.O. BOX 919092 SAN DIEGO, CA 92191-9092			EXAMINER DEAN, RAYMOND S	
			ART UNIT 2618	PAPER NUMBER
			MAIL DATE 07/09/2007	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

09/867,687

Applicant(s)

KESLING ET AL.

Examiner

Raymond S. Dean

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 14 September 2006.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-19 and 72-75 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-19 and 72-75 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 22 August 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- ☐ Notice of Informal Patent Application
- ☐ Other: _____

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on September 14, 2006 has been entered.

Response to Arguments

2. Applicant's arguments with respect to claim 1 have been considered but are moot in view of the new ground(s) of rejection.

Merriman et al. (US 7,039,599) teaches charging the sponsor a fee for broadcasting the advertisement, wherein the fee is based on the quantity of indications that are received, and wherein the identifier is used to calculate the fee (Cols. 1 lines 19 – 28, lines 35 – 43, 3 lines 5 – 11, 5 lines 46 – 50, in CPA model there will an identifier of the advertisement thus enabling the CPA pricing or charging to occur).

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

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(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1 – 3, 5, 18 – 19, and 73 – 75 are rejected under 35 U.S.C. 103(a) as being unpatentable over Noreen et al. (5,303,393) in view of Merriman et al. (US 7,039,599).

Regarding Claim 1, Noreen teaches a method for charging advertising fees, comprising the steps of: broadcasting an advertisement for a sponsor in a broadcast (Column 13 lines 15 – 32), wherein the broadcast includes an identifier that uniquely identifies the advertisement and at least one of the sponsor of the advertisement and a product advertised in the advertisement (Column 13 lines 15 – 32); receiving a quantity of electronic indications from persons who observe the advertisement, wherein the indications indicate interest in the product, and wherein the indications reference the identifier (Column 13 lines 33 – 67).

Noreen does not teach charging the sponsor a fee for broadcasting the advertisement, wherein the fee is based on the quantity of indications that are received, and wherein the identifier is used to calculate the fee.

Merriman teaches charging the sponsor a fee for broadcasting the advertisement, wherein the fee is based on the quantity of indications that are received, and wherein the identifier is used to calculate the fee (Cols. 1 lines 19 – 28, lines 35 – 43, 3 lines 5 – 11, 5 lines 46 – 50, in CPA model there will be an identifier of the advertisement thus enabling the CPA pricing or charging to occur).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to use the CPA model by Merriman in the system of Noreen for the purpose of generating a revenue stream as taught by Merriman.

Regarding Claim 2, Noreen in view of Merriman teaches all of the claimed limitations recited in Claim 1. Noreen further teaches a time at which and a channel on which the advertisement was broadcast (Column 13 lines 23 – 27, the carrier frequency is the channel).

Regarding Claim 3, Noreen in view of Merriman teaches all of the claimed limitations recited in Claim 1. Noreen further teaches receiving one of wireless messages requesting more information about the product and wireless messages requesting to purchase the product (Column 13 lines 42 – 67).

Regarding Claim 5, Noreen in view of Merriman teaches all of the claimed limitations recited in Claim 1. Noreen further teaches broadcasting from at least one satellite (Figure 1, Column 12 lines 12 – 15).

Regarding Claim 18, Noreen teaches a method for charging advertising fees comprising the steps of: broadcasting an advertisement associated with a plurality of sponsors (Column 4 lines 23 - 40, Column 13 lines 15 – 67, this is a digital broadcast radio satellite system that broadcasts multiple content nationwide to multiple subscribers, this includes an advertisement associated with a plurality of sponsors); broadcasting a unique program identifier with the advertisement (Column 13 lines 15 – 32); receiving a wireless order message to buy a product of a sponsor of the plurality of

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sponsors, wherein the wireless order message references the unique program identifier (Column 13 lines 33 – 67).

Noreen does not teach charging the sponsor a fee for the wireless order message received to buy the product of the sponsor, wherein the wireless order message references the unique program identifier, and wherein the unique program identifier is used to calculate the fee.

Merriman teaches charging the sponsor a fee for the order message received to buy the product of the sponsor, wherein the order message references the unique program identifier, wherein the order message references the unique program identifier, and wherein the unique program identifier is used to calculate the fee (Cols. 1 lines 19 – 28, lines 35 – 43, 3 lines 5 – 11, 5 lines 46 – 50, in CPA model there will be an identifier of the advertisement thus enabling the CPA pricing or charging to occur).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to use the CPA model by Merriman in the system of Noreen for the purpose of generating a revenue stream as taught by Merriman.

Regarding Claim 19, Noreen in view of Merriman teaches all of the claimed limitations recited in Claim 18. Noreen further teaches broadcasting from at least one satellite (Figure 1, Column 12 lines 12 – 15).

Regarding Claim 73, Noreen in view of Merriman teaches all of the claimed limitations recited in Claim 1. Noreen further teaches wherein the identifier is transmitted to a broadcast receiver along with the advertisement (Column 13 lines 15 – 42).

Regarding Claim 74, Noreen in view of Merriman teaches all of the claimed limitations recited in Claim 73. Noreen further teaches transmitting the electronic indication referencing the identifier directly from the broadcast receiver (Column 13 lines 42 – 67).

Regarding Claim 75, Noreen in view of Merriman teaches all of the claimed limitations recited in Claim 73. Merriman further teaches transmitting the electronic indication referencing the identifier via the internet (Cols. 1 lines 19 – 28, lines 35 – 43, 3 lines 5 – 11, 4 lines 16 – 24).

5. Claim 4 is rejected under 35 U.S.C. 103(a) as being unpatentable over Noreen et al. (5,303,393) (Noreen1) in view of Merriman et al. (US 7,039,599) and in further view of Noreen et al. (US 2002/0183059) (Noreen2).

Regarding Claim 4, Noreen1 in view of Merriman teaches all of the claimed limitations recited in Claim 1. Noreen1 in view of Merriman does not teach receiving downloads of the identifiers at a central hub.

Noreen2 teaches receiving downloads of the identifiers at a central hub (Section 0046 lines 1 – 24, the network operations center is the central hub).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the system of Noreen1 in view of Merriman with the feedback method of Noreen2 for the purpose of enabling a subscriber to select various advertisements while listening to the radio and then access the internet at a later time to review information pertaining to the various advertisements. The subscriber then does

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not need to make decisions immediately regarding the purchase of goods or services while listening to the radio broadcast as taught by Noreen2.

6. Claims 6 – 10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Noreen et al. (5,303,393) in view of Shah-Nazaroff et al. (US 2002/0053077) and in further view of Merriman et al. (US 7,039,599)

Regarding Claim 6, Noreen teaches broadcasting a first advertisement including a first identifier; receiving a first quantity of electronic indications from persons who observe the first advertisement, wherein the first quantity of electronic indications indicate interest in the first advertisement (Column 4 lines 23 - 40, Column 13 lines 15 – 67, this is a digital broadcast radio satellite system that broadcasts multiple content nationwide to multiple subscribers thus there will be multiple identifiers and a quantity of electronic indications in response to said identifiers) and wherein the first quantity of electronic indications reference the first identifier (Column 4 lines 23 - 40, Column 13 lines 15 – 67, this is a digital broadcast radio satellite system that broadcasts multiple content nationwide to multiple subscribers thus there will be multiple identifiers and a quantity of electronic indications in response to said identifiers); broadcasting a second advertisement including a second identifier; receiving a second quantity of electronic indications from persons who observe the second advertisement, wherein the second quantity of electronic indications indicate interest in the second advertisement (Column 4 lines 23 - 40, Column 13 lines 15 – 67, this is a digital broadcast radio satellite system that broadcasts multiple content nationwide to multiple subscribers thus there will be

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multiple identifiers and a quantity of electronic indications in response to said identifiers), and wherein the second quantity of electronic indications reference the second identifier (Column 4 lines 23 - 40, Column 13 lines 15 – 67, this is a digital broadcast radio satellite system that broadcasts multiple content nationwide to multiple subscribers thus there will be multiple identifiers and a quantity of electronic indications in response to said identifiers).

Noreen does not teach comparing the first quantity with the second quantity, wherein each of the first quantity of indications and the second quantity of indications references the respective first and second identifiers and charging a sponsor of at least the first advertisement a fee for broadcasting the first advertisement, wherein the fee is based on the first quantity of indications that are received, and wherein the first identifier is used to calculate the fee.

Shah-Nazaroff teaches comparing the first quantity with the second quantity, wherein each of the first quantity of indications and the second quantity of indications references the respective first and second identifiers (Sections 0021, 0022 lines 7 – 10, 0023 lines 8 – 9, 0042, 0043 lines 1 – 5, Shah-Nazaroff teaches a broadcast system that can broadcast multiple advertisements, Shah-Nazaroff further teaches a feedback method that enables a user interested/not interested in an advertisement to provide feedback about an advertisement, the feedback identifies the particular broadcast advertisement, a determination of the quantity of favorable responses about the advertisement will enable a rating to be generated, a sponsor of advertisements can then compare the ratings for multiple advertisements to the same category of

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subscribers thereby enabling said sponsor to determine which broadcast ranks the highest, since the ratings comprise a determination of quantities the comparison of the ratings comprises a comparison of the quantities, since the feedback identifies the particular broadcast advertisement said feedback will reference the identifier).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the system of Noreen with the feedback method of Shah-Nazaroff for the purpose of enabling an advertiser to target advertise broadcasts to subscribers for whom the broadcast ranks highly as taught by Shah-Nazaroff.

Merriman teaches charging the sponsor a fee for broadcasting the advertisement, wherein the fee is based on the quantity of indications that are received, and wherein the identifier is used to calculate the fee (Cols. 1 lines 19 – 28, lines 35 – 43, 3 lines 5 – 11, 5 lines 46 – 50, in CPA model there will be an identifier of the advertisement thus enabling the CPA pricing or charging to occur).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to use the CPA model by Merriman in the system of Noreen in view of Shah-Nazaroff for the purpose of generating a revenue stream as taught by Merriman.

Regarding Claim 7, Noreen in view of Shah-Nazaroff and in further view of Merriman teaches all of the claimed limitations recited in Claim 6. Noreen further teaches wherein the first advertisement and the second advertisement are the same and wherein the step of broadcasting the first advertisement occurs at a different time of day than the step of broadcasting the second advertisement (Column 4 lines 23 - 40,

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this is a digital broadcast radio satellite system that broadcasts multiple content nationwide to multiple subscribers on multiple channels, the content can also be the same thus this is an inherent characteristic).

Regarding Claim 8, Noreen in view of Shah-Nazaroff and further in view of Merriman teaches all of the claimed limitations recited in Claim 6. Noreen further teaches wherein the first advertisement and the second advertisement are the same, and wherein the step of broadcasting the first advertisement occurs on a different channel than the step of broadcasting the second advertisement (Column 4 lines 23 – 40, this is a digital broadcast radio satellite system that broadcasts multiple content nationwide to multiple subscribers on multiple channels, the content can also be the same thus this is an inherent characteristic).

Regarding Claim 9, Noreen in view of Shah-Nazaroff and in further view of Merriman teaches all of the claimed limitations recited in Claim 6. Noreen further teaches wherein the first advertisement and the second advertisement are different, wherein the first advertisement is broadcast at a particular time of day and on a certain channel, and wherein the second advertisement is broadcast at the particular time of day and on the certain channel (Column 4 lines 23 – 40, this is a digital broadcast radio satellite system that broadcasts multiple content nationwide to multiple subscribers on multiple channels thus this is an inherent characteristic).

Regarding Claim 10, Noreen in view of Shah-Nazaroff and in further view of Merriman teaches all of the claimed limitations recited in Claim 6. Noreen further teaches broadcasting from at least one satellite (Figure 1, Column 12 lines 12 – 15).

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7. Claims 11 – 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Noreen et al. (5,303,393) (Noreen1) in view of Noreen et al. (US 2002/0183059) (Noreen2) and in further view of Merriman et al. (US 7,039,599).

Regarding Claim 11, Noreen1 teaches a method for charging advertising fees comprising the steps of: broadcasting an advertisement of a sponsor and broadcasting a unique program identifier with the advertisement (Column 13 lines 15 – 32).

Noreen1 does not teach recording the unique program identifier in memory devices in response to users' indicating interest in the advertisement, downloading the unique program identifier from the memory devices to a central hub; and charging the sponsor a fee for each unique program identifier that is downloaded, wherein the unique program identifier is used to calculate the fee.

Noreen2 teaches recording the unique program identifier in memory devices in response to users' indicating interest in the advertisement (Section 0046 lines 1 – 24, the responses will identify the advertisements, said responses will be recorded at the radio network ground station for further transfer to the network operations center) and downloading the unique program identifier from the memory devices to a central hub (Section 0046 lines 1 – 24, the network operations center is the central hub).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the system of Noreen1 with the feedback method of Noreen2 for the purpose of enabling a subscriber to select various advertisements while listening to the radio and then access the internet at a later time to review information pertaining to the various advertisements. The subscriber then does not need to make

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decisions immediately regarding the purchase of goods or services while listening to the radio broadcast as taught by Noreen2.

Merriman teaches charging the sponsor a fee for each unique program identifier that is downloaded, wherein the unique program identifier is used to calculate the fee (Cols. 1 lines 19 – 28, lines 35 – 43, 3 lines 5 – 11, 5 lines 46 – 50, in CPA model there will be an identifier of the advertisement thus enabling the CPA pricing or charging to occur).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to use the CPA model by Merriman in the system of Noreen1 in view of Noreen2 for the purpose of generating a revenue stream as taught by Merriman.

Regarding Claim 12, Noreen1 in view of Noreen2 in further view of Merriman teaches all of the claimed limitations recited in Claim 11. Noreen2 further teaches downloading to a portable device via one of a wireless and a temporary wired connection and employing the portable device to effect the downloading (Figure 1, Section 0046 lines 1 – 24).

Regarding Claim 13, Noreen1 in view of Noreen2 and in further view of Merriman teaches all of the claimed limitations recited in Claim 12. Noreen2 further teaches a personal digital assistant (Section 0046 lines 1 - 24).

Regarding Claim 14, Noreen1 in view of Noreen2 and in further view of Merriman teaches all of the claimed limitations recited in Claim 12. Noreen2 further teaches one of an infrared link and a radio frequency link (Figure 1, Section 0046 lines 1 – 24, computer network (111) comprises WLANs).

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Regarding Claim 15, Noreen1 in view of Noreen2 in further view of Merriman teaches all of the claimed limitations recited in Claim 11. Noreen1 further teaches presenting a second advertisement of a sponsor (Column 4 lines 23 - 40, Column 13 lines 15 - 67, this is a digital broadcast radio satellite system that broadcasts multiple content nationwide to multiple subscribers thus there will be multiple advertisements), Noreen2 further teaches a central hub (Figure 1, Section 0046 lines 1 - 24), receiving click-through commands from users to activate the second advertisement (Sections 0012, 0013 lines 1 - 14); launching an order screen of the second advertisement that presents a product for sale; passing the unique program identifier to the order screen (Sections 0012, 0013 lines 1 - 14, the URL is the identifier); accepting an order for the product and associating the order with the unique program identifier (Sections 0012, 0013 lines 1 - 14, the URL is the identifier); Merriman further teaches charging the sponsor a commission on the order (Cols. 1 lines 19 - 28, lines 35 - 43, 3 lines 5 - 11, 5 lines 46 - 50, in CPA model there will be an identifier of the advertisement thus enabling the CPA pricing or charging to occur).

Regarding Claim 16, Noreen1 in view of Noreen2 and in further view of Merriman teaches all of the claimed limitations recited in Claim 11. Noreen1 further teaches presenting a second advertisement of a second sponsor (Column 4 lines 23 - 40, Column 13 lines 15 - 67, this is a digital broadcast radio satellite system that broadcasts multiple content nationwide to multiple subscribers thus there will be multiple advertisements), Noreen2 further teaches a web site (Sections 0012, 0013 lines 1 - 14), receiving click-through commands from users to activate the second advertisement

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(Sections 0012, 0013 lines 1 – 14); launching an order screen of the second advertisement that presents a product for sale; passing the unique program identifier to the order screen (Sections 0012, 0013 lines 1 – 14, the URL is the identifier); accepting an order for the product and associating the order with the unique program identifier (Sections 0012, 0013 lines 1 – 14, the URL is the identifier); Merriman further teaches charging the sponsor a commission on the order (Cols. 1 lines 19 – 28, lines 35 – 43, 3 lines 5 – 11, 5 lines 46 – 50, in CPA model there will be an identifier of the advertisement thus enabling the CPA pricing or charging to occur).

Regarding Claim 17, Noreen1 in view of Noreen2 and in further view of Merriman teaches all of the claimed limitations recited in Claim 11. Noreen1 further teaches broadcasting from at least one satellite (Figure 1, Column 12 lines 12 – 15).

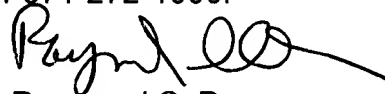
Conclusion

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Raymond S. Dean whose telephone number is 571-272-7877. The examiner can normally be reached on Monday-Friday 6:00-2:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Edward F. Urban can be reached on 571-272-7899. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



Raymond S. Dean
June 12, 2007



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